

EA



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,457	08/08/2001	Nobuya Okayama	500.40470X00	9085
24956	7590	09/20/2005		
MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C. 1800 DIAGONAL ROAD SUITE 370 ALEXANDRIA, VA 22314			EXAMINER OUELLETTE, JONATHAN P	
			ART UNIT 3629	PAPER NUMBER

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/923,457

Applicant(s)

OKAYAMA ET AL.

Examiner

Jonathan Ouellette

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20020606, 20040114, 2004/1101
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 34 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Archibald et al. (US 5,825,883).**
3. As per **independent Claim 34**, Archibald discloses a calculating method of licensing fee of digital contents comprising a step of counting the number of pages displaying digital contents (number of actions or invocations) and a step of calculating a fee from the number of displayed pages (C3-C4, C8 L38-56, Claims 1-4).
4. As per **independent Claim 35**, Archibald discloses a calculating method of licensing fee of digital contents comprising a step of counting a display time (time increments) during which digital contents are displayed and a step of calculating a fee in accordance with the display time (C3-C4, C8 L38-56, Claims 1-4).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention

was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-33, 36, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Archibald et al. (US 5,825,883).**
7. As per **independent Claims 1, 36, and 37**, Archibald discloses a calculating method (system, computer readable recording medium storing a program) of licensing fee of digital contents comprising: a step of distributing digital contents from a center side distribution apparatus to a terminal apparatus (Fig.1, C3-C4); a step of collecting an audiovisual fee for digital contents from a user; a step of allowing digital contents capable of being accessed at a limited place (personal PC or mobile PC unit); a step of calculating the number of audiovisual times of digital contents viewed and listened at the terminal apparatus (meter module); and a step of calculating a copyright fee in accordance with the calculated number of audiovisual times (C3-C4, C8 L38-56, Claims 1-4).
8. Archibald fails to expressly disclose wherein the digital contents are distributed via a shop side distribution apparatus.
9. However, Archibald does disclose distributing the digital applications through several channels (C4 L35-40), and it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a store or shop as a distribution source.
10. Furthermore, Archibald fails to expressly disclose wherein the digital contents are distributed within a limited time period.
11. However, Archibald does disclose providing user access to several types of digital content and metering use with several different methods (C3-C4, C8 L38-56), and it

would have been obvious to one of ordinary skill in the art at the time the invention was made to limit the availability of certain digital content, to allow better control of released content and allow better distribution of newer releases.

12. As per Claim 2, Archibald discloses making the terminal apparatus recognize the contents of a portable recording medium storing an audiovisual period of viewing and listening digital contents at the terminal apparatus (digital content can be released to users through network or recorded medium).
13. As per Claims 3 and 4, Archibald discloses recording personal operation history information and personal preference information managed in the terminal apparatus in a portable recording medium (user ID, user data records).
14. As per Claims 5-8, Archibald discloses allowing a trial read of digital contents at the terminal apparatus capable of viewing and listening the digital contents (Fig.4, C9 L26-34, trial period).
15. As per Claims 9-16, Archibald fails to expressly disclose prolonging an audiovisual time of digital contents if an electronic advertisement is viewed and listened at the terminal apparatus capable of viewing and listening the digital contents.
16. However, Archibald does disclose offering discounts and incentives to users (C9 L13-25), and Official Notice is given that compensating users for viewing advertisements was well known to one of ordinary skill at the time the invention was made; and it would have been obvious to compensate the user with incentives related to receiving digital content.
17. As per Claims 17-32, Archibald fails to expressly disclose printing a portion or all of digital contents, a step of checking whether the digital contents can be printed, a step of

calculating a copyright fee of the printed digital contents, and a step of displaying the calculated result on a display.

18. However, Archibald does disclose monitoring user actions with digital contents and calculating a fee based on the use of the digital content (C3-C4), and printing information based on digital content was well known to one of ordinary skill in the art at the time the invention was made.
19. Therefore, it would have been obvious to include printing a se to be monitored by the metering system described by Archibald.
20. As per **independent Claim 33**, Archibald discloses a calculating method of licensing fee of digital contents comprising a step of collecting an audiovisual fee of digital contents from a user, a step of outputting the digital contents, a step of calculating the number of audiovisual times of the digital contents, and a step of calculating a copyright fee in accordance with the calculated number of audiovisual times (C3-C4, C8 L38-56, Claims 1-4).
21. Archibald fails to expressly disclose wherein the digital contents are distributed within a limited time period.
22. However, Archibald does disclose providing user access to several types of digital content and metering use with several different methods (C3-C4, C8 L38-56), and it would have been obvious to one of ordinary skill in the art at the time the invention was made to limit the availability of certain digital content, to allow better control of released content and allow better distribution of newer releases.

Conclusion

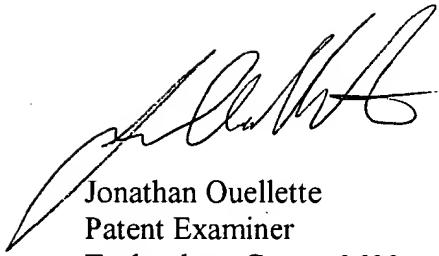
23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
24. Additional Literature has been referenced on the attached PTO-892 form, and the Examiner suggests the applicant review these documents before submitting any amendments.
25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
26. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (571) 273-8300 for all official communications.
27. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Office of Initial Patent Examination whose telephone number is (703) 308-1202.

Application/Control Number: 09/923,457

Page 7

Art Unit: 3629

September 16, 2005

A handwritten signature in black ink, appearing to read 'Jonathan Ouellette', is written over the printed name and title.

Jonathan Ouellette
Patent Examiner
Technology Center 3600